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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,895	07/24/2001	GERALD ANTON OFNER	046-7001.30	3043
466	7590	09/08/2004	EXAMINER	
YOUNG & THOMPSON			FINEMAN, LEE A	
745 SOUTH 23RD STREET 2ND FLOOR				
ARLINGTON, VA 22202			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/889,895	OFNER, GERALD ANTON	
	Examiner	Art Unit	
	Lee Fineman	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 6-63 is/are pending in the application.
 - 4a) Of the above claim(s) 6-61 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,62 and 63 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 7/24/01 & 4/30/03 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

This Office Action is in response to an amendment filed 17 June 2004 in which claim 63 was added. Claims 1 and 6-63 are pending in which claims 6-67 are withdrawn.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Austria on 30 November 1999. It is noted, however, that applicant has not filed a certified copy of the A 2016/99 application as required by 35 U.S.C. 119(b).

Receipt is acknowledged of Austria application A1994/99, filed 24 November 1999, submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. Applicant asserts that the unnumbered curved element in fig. 11 is the path along which optical element (11) travels and the applicant has directed the examiner to page 22 of the specification, which is asserted as providing an embodiment having three separate and distinct lenses. However, this depiction commonly represents a two-piece objective lens in the art and a review of the written specification fails to support the unnumbered element being a guide as asserted for the embodiment as depicted in fig. 11. Further, the applicant also admits (page 14, lines 11-14) that no figure is currently supplied which illustrates this embodiment. As such the drawings are objected to and the applicant is required to provide an illustration thereof. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 63 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

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of the claimed invention. Claim 63 has the limitation “wherein said at least one optical element is between the at least one objective lens and the eyepiece.” The drawings and the specification fail to disclose any specific position of the optical element as between the objective lens and the eyepiece. Only fig 1 even shows the optical element and in that embodiment it is the objective lens and therefore cannot be between itself and the eyepiece.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states the limitations “at least one objective lens and one eyepiece” and “at least one optical element positioned and arranged to match parallaxes...movable along a curved path” which implies three distinct optical lenses. The specification (fig 1) describes only the situation when the objective lens (11) is the moving optical element. Thus claim 1 appears to be a misdescription of the invention. For examination purposes, examiner is taking the objective lens and moving optical element to be the same element as the applicant also stated in the remarks section of the amendment filed 8 January 2004 that “specifically, claim 1 recites that the objective lens is movable along a curved path.” The dependent claims inherit the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanda in view of Austrian Patent Publication No. AT 000307 U1 (henceforth AT-307).

Regarding claim 1 and 62, Kanda discloses a vision aid (fig. 5) in the form of telescopic spectacles with two lens systems which each comprise at least one objective lens (5) and one eyepiece (4), a focusing means (6) which changes the focal length to adjust the lens systems according to the distance of the telescopic spectacle from the object (fig. 6), and at least one optical element (5) positioned and arranged to match parallaxes between the lens systems of the vision aid to the focal length which has been set according to the distance of the telescopic spectacles from an object (fig. 6, column 3, line 55-column 4, line 2), such that in each said lens system, said at least one optical element is movable along a curved path (from connector 13) that crosses a beam path internal to the vision aid for changing an angle between external beam paths which run out of the respective lens systems toward the object; and wherein in each said lens system, the at least one optical element is rotatable along an axis perpendicular to said curved path so that said at least one optical element tilts when said al least one optical element is moved along said curved path (column 7, lines 23-31). Kanda discloses the

claimed invention except for a means for changing the magnification factor of the lens systems and the focusing means being an autofocus means. AT-307 teaches telescopic spectacles with two lens systems (fig. 1) with a means for changing the magnification factor of the lens systems (13, 14) and an autofocus means (4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the means for changing the magnification factor of AT-307 to the system of Kanda to provide the viewer with more flexibility in viewing the image with a broader range of magnifications and to make the focusing mean of Kanda an autofocus means as suggested by AT-307 to provide fast, accurate focusing of the object.

Regarding claim 63, Kanda in view of At-307 discloses the claimed invention except for wherein said at least one optical element is between the at least one objective and the eyepiece. However, an additional lens between the objective and eyepiece would have been obvious at the time of the invention for magnification or relay purposes while providing additional degrees of freedom in designing the system.

Response to Arguments

9. Applicant's arguments filed 17 June 2004 have been fully considered but they are not persuasive.

Applicant argues that Kanda has only an objective and eyepiece and does not teach or suggest an optical element that is adjustable for matching parallax, which is also distinct from the objective lens and the eyepiece. However, it is the examiner's position that the language as claimed does not prevent the objective of Kanda from also being the

optical element as it meets all the structure and function of the optical element and there is no claimed limitation that prevents it from also being the optical element.

Applicant also argues that Kanda only adjusts a distance between eyes and does not disclose or suggest that parallaxes are matched. The examiner respectfully disagrees. Matching parallax entails adjusting the angle (labeled 13 in the instant application) to provide a better merged imaged at a given focal length. Clearly, as shown in fig. 5 of Kanda, the hinged holder (13 and 6) of optical element (5) is able to adjust to any angle in a 90 degree arc that provides matching parallax by being able to change that angle. If the eyepiece is not moved, this same hinged movement is clearly a curved path (from connector 13) that crosses a beam path internal to the vision aid for changing an angle between external beam paths which run out of the respective lens systems toward the object.

Applicant argues that page 22, lines 1-15 of the specification provides support for claim 1 with an embodiment having three separate and distinct lenses. The examiner respectfully disagrees. There is nothing in these lines of the specification that explicitly teaches that the objective (70) must be a different element than optical element (11), which again is only shown in the drawings as one optical element that is both an objective AND matching parallax in fig. 1.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LAF
LAF
August 25, 2004

MAR
MARK A. ROBINSON
PRIMARY EXAMINER